SEP 5 1940
CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1939

No. 398

THE HAMILTON LABORATORIES, INC.
Petitioner

vs.

SAMUEL E. MASSENGILL, doing business as
THE S. E. MASSENGILL COMPANY
Respondent

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SIXTH CIRCUIT

and

BRIEF IN SUPPORT THEREOF

W. B. MORTON
Counsel for Petitioner

SUBJECT INDEX

	PAGE
Petition for Writ of Certiorari	1
Summary Statement of the Matter Involved	2
Questions Presented	4
Reasons Relied on for the Allowance of the Writ	4
Brief in Support of Petition for Writ of Certiorari	7
Opinions of the Courts Below	7
Jurisdiction	7
Statement of the Case	7
Specification of Errors	7
Summary of Argument	8
Argument	8
I. The typewritten thesis deposited by the Patentee in the Iowa State College Library was not a printed publication within the meaning of R. S. 4886, U. S. Code, Title 35, Sec. 31	8
II. Patent claims to a defined group of chemical compounds possessing the essential characteristics for the stated purpose are not invalid (The Incandescent Lamp Patent, 159 U. S. 465)	11
III. The claims of the patent are not invalid because based on a discovery made in the course of research in a field recommended for study in a prior publication (Corona v. Dovan, 276 U. S. 358)	13
IV. The patentee is not estopped to contest the pertinence of a prior patent cited during the Patent Office prosecution of a companion application (Smith v. Snow, 294 U. S. 1)	16
Conclusion	16

AUTHORITIES CITED

PAGES

Britton v. White Mfg. Co., 61 Fed. 93 ..... 4, 9, 10

Corona Co. v. Dovan Corpn., 276 U. S. 358, 368-9 ..... 5, 9, 12, 14

John Crossley and Sons v. Hogg, 83 Fed. 488 ..... 4, 9

Ex parte Geer, 3 U. S. Pat. Q. 131 ..... 5, 11

In re Ellis, 37 App. D. C. 203 ..... 5, 12

In re Walker, 70 F. (2nd) 1008 ..... 5, 12

Report of Senate Committee, 71st Congress, 2nd Session—Report No. 315, p. 11 15

Smith v. Snow, 294 U. S. 1, 16 ..... 5, 16

The Incandescent Lamp Patent, 159 U. S. 465 12

IN THE

Supreme Court of the United States

OCTOBER TERM 1939

No.

HAMILTON LABORATORIES, INC.

Petitioner

vs.

SAMUEL E. MASSENGILL doing business as the S. E. MASSENGILL COMPANY

Respondent

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SIXTH CIRCUIT

To The Honorable The Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, Hamilton Laboratories, Inc., respectfully prays for a writ of certiorari to the United States Circuit Court of Appeals for the Sixth Circuit to review the decision of that Court in the above entitled case (reported 111 F. (2d) 584). (R. p. 723-30) A petition for rehearing was duly presented and denied on June 6, 1940. (R. p. 740)

A certified transcript of the record in the case, including the proceedings in said Circuit Court of Appeals is furnished herewith in compliance with Rule 38 of the rules of this Court.

Summary Statement of the Matter Involved

This is a patent infringement case. The patentee of the patent in suit discovered that chemical compounds containing mercury in a certain form were valuable pharmaceutical germicides for the treatment of blood-poisoning, gangrene, and other serious infections. In due course a patent was issued to his assignee, Hamilton Laboratories, Inc., covering pharmaceutical germicides containing compounds of mercury wherein the mercury was in the particular form found to be effective for the purposes described.

The patent is not limited to a single chemical substance of stated formula but covers a well defined group of compounds having the common characteristics of containing mercury in the form specified and having a similar action upon solution in water. (R. p. 251, col. 1, ll. 7-13)

There are a large number of such compounds possible of synthesis according to well established laws of chemistry. The patentee and his assignee made and tested some twenty different compounds and found them to have the same characteristic action and to be similarly effective against pathogenic germs. (R. p. 28) No evidence was submitted of the making of any compounds falling within the claimed group which did not have the same characteristic and effective action.

The patentee was engaged in research with compounds of the defined group for a period of years. More than two years prior to filing his application for the patent in suit, he submitted, as a candidate for a post-graduate degree, a thesis (R. p. 413) discussing certain properties of some of the compounds included in the claimed group. The thesis was typewritten and was deposited in the library of the college (Iowa State College) where the patentee was a graduate student. The copy was available to students there and to other libraries having exchange arrangements. Prior to the grant of his patent (but not more than two

years prior to his application) the patentee contributed to the recognized journals of the medical profession several articles (R. pp. 458, 469, 475) descriptive of the use of the claimed compounds in the treatment of diseases involving serious infection and at the time the patent was issued some ten or twelve manufacturers of drugs and chemicals were supplying several of the chemical compounds to the medical profession. (R. p. 42) Upon the issuance of the patent in suit all these concerns except the respondent discontinued their manufacture of the patented compounds. (R. p. 44) This suit was thereupon brought against this respondent in the District Court for the Eastern District of Tennessee where the defendant resides. The District Court dismissed the complaint, holding the patent invalid. On appeal to the Circuit Court of Appeals for the Sixth Circuit the decree of the District Court was affirmed. In its opinion the Court of Appeals based its ruling of invalidity on the following grounds:

(1) That the patentee's typewritten thesis deposited in the library of Iowa State College constituted "a printed publication" within the meaning of the patent laws. (R. p. 724)

(2) That the claims were too broad because they included within their scope compounds which had not been made and tested. (R. p. 729)

(3) That the patentee's discovery was not patentable invention because it resulted from laboratory research in a field recommended for exploration in a prior publication. (R. p. 728)

(4) As anticipated by a prior patent cited against similar claims during the prosecution of a companion application subsequently abandoned. (R. p. 730)

Questions Presented

(1) Is a typewritten thesis filed in a college library a "printed publication"?

(2) Are patents to chemical compounds and processes involving their use invalid if drawn to cover a range of equivalents beyond the specific compounds actually used?

(3) Is the discovery of new, useful and unique properties in certain chemical compounds any less a patentable invention because made in the course of research in a designated field?

(4) Is a patentee estopped to contest the pertinence of a pleaded prior patent because of its citation by the Patent Office in the prosecution of a companion application thereafter abandoned?

Reasons Relied on for the Allowance of the Writ

1. In its ruling on the significance of the patentee's typewritten thesis the Circuit Court of Appeals has decided an important question of Federal Law which has not been, but should be, settled by this Court.

In holding that such a document constitutes a statutory bar to the validity of a patent if written more than two years (now one year) prior to the application date, the Court has enormously increased the field of search that must be investigated to determine the validity of a patent.

So far as your petitioner is aware, this Court has not heretofore construed the phrase "printed publication" (R. S. 4886) with respect to subject-matter in any way analogous to that presented here. The ruling of the Court of Appeals is not supported by the authorities on which it purports to be founded, viz., *John Crossley and Sons* v. *Hogg*, 83 Fed. 488 and *Britton* v. *White Mfg. Co.*, 61 Fed. 93.

2. In ruling that the claims are too broad because not limited to exclude all compounds of the designated class not tried in actual practice, the Court of Appeals has decided an important question of Federal Law which has not been but should be settled by this Court.

The decision of the Circuit Court of Appeals is directly contrary to the established practice of the Patent Office and the Court of Customs and Patent Appeals governing the scope of claims granted in patents to chemical processes.

In re Ellis, 37 App. D. C. 203
In re Walker, 70 F. (2nd) 1008
Ex parte Geer, 3 U. S. Pat. Q. 131.

3. In ruling that the patent is invalid because the claimed discovery resulted from research in an indicated field, the Court of Appeals has decided an important question of Federal Law contrary to the established rule of this Court in cases involving patents for "discoveries". *Corona Co.* v. *Dovan Corp.*, 276 U. S. 358, 368-9.

4. The Court of Appeals supports its ruling that the patent in suit is invalid because of a prior patent to the use of certain organic mercury compounds as seed disinfectants, upon the failure of the patentee to contest a rejection in the Patent Office *of a prior application* based on that patent. The prior application was later abandoned and a new application filed upon which the patent in suit was ultimately granted.

The decision of the Court of Appeals on this question is contrary to the established rule of this Court in cases involving Patent Office proceedings. *Smith* v. *Snow*, 294 U. S. 1, 16.

WHEREFORE, your petitioner respectfully prays that a writ of certiorari be issued out of and under the seal of this Honorable Court, directed to the Circuit Court of

Appeals for the Sixth Circuit, commanding that court to certify and to send to this Court for its review and determination, on a day certain to be therein named, a full and complete transcript of the record and all proceedings in the case numbered and entitled on its docket, No. 8238, Hamilton Laboratories, Inc. Appellant v. Samuel E. Massengill, doing business as The S. E. Massengill Company, Appellee, and that the said decree of the Circuit Court of Appeals for the Sixth Circuit may be reversed by this Honorable Court, and that your petitioners may have such other and further relief in the premises as to this Honorable Court may seem meet and just; and your petitioner will ever pray.

HAMILTON LABORATORIES, INC.
By W. B. MORTON,
Counsel for Petitioner